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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,186	12/28/2001	Harish Mahalingam	680.0054USU	7732

7590 11/05/2002

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EXAMINER
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PATTEN, PATRICIA A

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 11/05/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/034,186

Applicant(s)

Mahalingam et al.

Examiner

Patricia Patten

Art Unit

1651



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-30 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit:

## **DETAILED ACTION**

### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 11-13, drawn to a composition comprising an agent which inhibits DOPAchrome tautomerase and/or DHICA polymerase, classified in class 549 subclass 490 for example.
- II. Claims 14 and 15, drawn to a method for lightening skin via application of the composition of Claim 1, classified in class 424, subclass 63 for example.
- III. Claims 16-21, drawn to a composition comprising a perilla leaf extract and a vehicle, classified in class 424, subclass 774 for example.
- IV. Claims 22-23, drawn to a method for lightening skin via application of the composition of claim 17, classified in class 424, subclass 725 for example.
- V. Claims 24-28, drawn to a composition comprising a topical lightening agent such as cashew nut milk and a vehicle, classified in class 424, subclass 757 for example.
- VI. Claims 29-30, drawn to a method for lightening skin via application of the composition of claim 24, classified in class 424, subclass 769 for example.

Art Unit:

The inventions are distinct, each from the other because of the following reasons:

Inventions I&II, III&VI, V&VI and are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case each method could be carried out with a materially different product since the composition claims are broad enough to encompass a variety of compounds. For example, claim 1 may be drawn to any composition/extract/crude material which may inhibit either DOPAchrome tautomerase or DHICA polymerase which may provide additional effects depending on the agent/extract which is employed. Again, with regard to Groups III&VI, the method of Group VI could be carried out with any perilla leaf extract. The claim is broad enough to encompass organic solvent, water, alcoholic or aqueous/alcoholic extracts, and thus could be carried out with any of these different products. The method of Group VI could be, as evidenced by the claims themselves, carried out with numerous agents such as coconut water, palm water or walnut milk for example.

Inventions I, III and V (compositions) are unrelated to each other. Inventions II, IV and VI (methods) are also unrelated to each other. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case

Art Unit:

each of the respective compositions could employ entirely different products which would result in varying effects when applied to an individual. For example, the inhibitors of Group I could be a chemical compound which is synthesized, not necessarily extracted from any type of plant material. Further, Group III which employs an extract of Perilla leaf is an entirely different product than what is disclosed in Group V which recites products such as cashew milk and almond nut milk.

Therefore, the inventions are independent since they are not disclosed as capable of use together, they have different modes of operation, they have different functions, and/or they have different effects. One would not have to practice the various methods at the same time to practice just one method alone.

The search for each of the above inventions is not co-extensive particularly with regard to the literature search. Further, a reference which would anticipate the invention of one group would not necessarily anticipate or even make obvious another group.

Because these inventions are distinct for the reasons given above and the search required for each Group is not required for the others, restriction for examination purposes as indicated is proper. Applicant is advised that the response to this requirement, to be complete, must include an election of the invention to be examined even though the requirement be traversed.

Art Unit:

A telephone call was made to Charles Ruggiero on 9/10/02 to request an oral election to the above restriction requirement, but did not result in an election being made

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Patricia Patten, whose telephone number is (703)308-1189. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (703) 306-3220. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


Application/Control Number: 10/034,186

Page 6

Art Unit:

30 October 2002

Patricia Patten

A handwritten signature in black ink, appearing to read "Patricia Patten", followed by a long horizontal line extending to the right.